

In re Application: Schack et al.

Application No.: 10/591,818

Filed: September 6, 2006

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REMARKS

Applicants appreciate the thorough examination of the present application as evidenced by the Office Action of February 17, 2009 (hereinafter "Office Action"). However, Applicants respectfully request reconsideration of the outstanding rejections for the reasons discussed below.

Ying Is Not Prior Art Under 35 USC §103(c)

Claims 8, 12, and 14-20 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 7,339,530 to Ying et al. ("Ying") in view of U.S. Patent No. 6,049,314 to Munson et al. ("Munson"). However, Applicants respectfully submit that Ying is disqualified under 35 USC §103(c) as prior art in a rejection under 35 USC §103(a), pursuant to MPEP §§706.02(I)(1) and 706.02(I)(2). Applicants will now make the requisite showing.

The present application claims priority from U.S. Provisional Application No. 60/554,282, filed March 18, 2004, which is prior to both the issue date (March 4, 2008) and the publication date (May 24, 2007) of Ying, and is less than one year after the effective filing date of Ying (September 23, 2003, which is the filing date of Provisional application No. 60/505,391 from which Ying claims priority). *See* MPEP §2136.03 (II). As such, Ying is not prior art to the present application under either 35 USC § 102(a) or (b). Accordingly, for purposes of 35 USC §103(a), Ying only qualifies as prior art under 35 USC §102(e).

Pursuant to 35 USC § 103(c), "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." *See* MPEP, §2146. Applicants note that, at the time the present invention was made, the subject matter of both Ying and the present application were owned by or subject to an obligation of assignment to SonyEricsson Mobile Communications AB. Ying is, therefore, disqualified under 35 USC §103(c) as prior art in the rejection under 35 USC §103(a) pursuant to MPEP §§706.02(I)(1) and 706.02(I)(2), by virtue of common ownership.

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Pursuant to these sections of the MPEP, Applicants hereby submit the following statement of common ownership:

Statement of Common Ownership

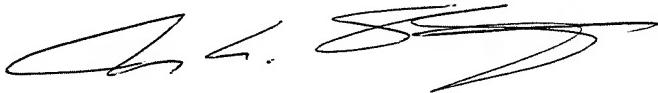
Application Serial No. 10/591,818 and U.S. Patent No. 7,339,530 to Ying et al. were, at the time of the invention of Application Serial No. 10/591,818, owned by or subject to an obligation of assignment to Sony Ericsson Mobile Communications AB.

In view of the above statement, Applicants submit that Ying does not qualify as prior art under U.S. law. Applicants submit that the above statement should not be construed as an admission as to the unpatentability of any of the pending claims over the teachings of Ying and/or the other cited references, nor that these references could be successfully combined under 35 USC §103. Since Ying is simply not prior art under U.S. law, any further discussion of patentability is irrelevant. Thus, Applicants respectfully request withdrawal of the rejections of the pending claims under 35 USC §103(a) for at least these reasons.

Conclusion

Accordingly, in light of the above amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. Thus, Applicants respectfully request allowance of the pending claims and passing the application to issue. Applicants encourage the Examiner to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,



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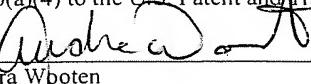
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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on May 18, 2009.


Audra Wooten